

No. 15104

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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ORIENTAL FOODS, INC.,

*Appellant,*

*vs.*

CHUN KING SALES, INC. and JENO F. PAULUCCI,

*Appellees.*

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CHUN KING SALES, INC. and JENO F. PAULUCCI,

*Appellees-Cross-Appellants,*

*vs.*

ORIENTAL FOODS, INC.,

*Appellant-Cross-Appellee.*

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## ANSWERING BRIEF OF PLAINTIFFS- APPELLEES-APPELLANTS.

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## TOPICAL INDEX

PAGE

### I.

Statement of the case.....	1
A. Background of the invention.....	1
B. The state of the art prior to Paulucci's invention.....	2
C. The invention .....	3

### II.

Argument .....	5
1. The operation of the accused machine.....	5
2. Interpretation of the Paulucci patent.....	9
3. The Paulucci patent is valid.....	13
4. Chun King's prior taping operation.....	14
5. Oriental's prior taping operation.....	15
6. The Johnson patent 2,652,166 does not invalidate.....	16
7. Nifong patent 2,120,504 does not invalidate.....	18
8. Claims 2 and 3 are not in issue.....	18

### III.

Conclusion .....	19
------------------	----

## TABLE OF AUTHORITIES CITED

CASES	PAGE
Coleman Co., Inc. v. Holly Mfg. Co. (9 Cir., 1956), 233 F. 2d 71 .....	13
Electric Storage Battery Co. v. Shimadzu (1939), 307 U. S. 5....	14
Fleming, Ex parte, 1907 C. D. 51.....	9
Jesse E. Hall, et al. v. Kenneth A. Wright, et al., U. S. C. A. Appeal No. 14626.....	20
Musher Foundation, Inc. v. Alba Trading Co., Inc. (2 Cir., 1945), 150 F. 2d 885.....	10, 12
Pacific Laboratories v. Solex Laboratories (9 Cir., 1953), 209 F. 2d 529.....	14, 15
Stone, Ex parte, 1902 C. D. 434.....	9
Whiteman v. Mathews (9 Cir., 1954), 216 F. 2d 712.....	16

### RULES

Rules of Practice of the United States Patent Office, Rule 312 .....	9, 12
--	-------

### TEXTBOOKS

Patent Office Rules and Practice (Amdur).....	10
Patent Office Practice (3rd Ed., McCrady).....	10

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## ANSWERING BRIEF OF PLAINTIFFS- APPELLEES-APPELLANTS.

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### Statement of the Case.

#### (a) Background of the Invention.

In the merchandising of Chinese-American foods the melange or stew of the product is in a separate can from the noodles or rice. The melange or stew may be of several types, such as beef, chicken or meatless. When the melange is poured over rice it is termed Chop Suey and when poured over noodles it is called Chow Mein [R. 124].

Since the consumer, in addition to purchasing the melange or stew, also usually purchases either rice or noodles, it is highly desirable to place the can of melange or stew on the grocer's shelf already attached to either a can of rice or noodles. In this manner the products lend

themselves to promotional programs such as a one cent sale or two-in-one sale as well as increasing the convenience of the storekeeper and the purchaser. Also it is desirable to cook the meat and sauce separate from the vegetables, to can same separately to improve the flavor and quality of the melange. Such cans are then taped together and called a divider pack [R. 117, 118].

Both parties as well as the remainder of the art, struggled with the problem of how to secure the cans together in a manner which would be satisfactory prior to the invention defined by Claim 1 of the Paulucci patent in suit.

**(b) The State of the Art Prior to Paulucci's Invention.**

Prior to Paulucci's invention Chung King tried to tape cans in end-to-end relationship. Problems arose because the cans were of different weights and the beads thereof were greasy. In May of 1949 the method utilized consisted of "We would take the tape and loosen it from the dispenser and roll the cans into the tape, and then tack the end on to the other end of the circumference of the bead" [R. 119]. In other words, the two cans were placed in end-to-end relationship and rolled onto the loose tape until the tape surrounded the cans [R. 426, 428]. This method of taping was highly unsatisfactory in that the tape would ruffle and the cans would come apart [R. 120]. It was necessary to supply brokers and salesmen with tape so that they could retape those cans which came apart [R. 121].

Oriental, assertedly in June of 1949, tried to tape cans in end-to-end relationship and continued until early 1950. This operation involved grasping the two cans with the left hand, picking up a pre-cut piece of tape, tacking one end of the tape to the cans and then rotating the cans

manually while guiding the tape onto the beads [R. 474]. However, this process which differs materially from the patented process, was unsatisfactory and within approximately six months was abandoned in favor of cardboard cartons such as Exhibit 53 even though taping was admitted to be more economical [R. 492, 495].

When Chun King experienced difficulty with its taping process, Minnesota Mining & Manufacturing Company, in order to promote sales of its tape to Chun King, endeavored to construct a machine to perform the taping operation. This machine which is shown and described in the Johnson patent No. 2,652,166, was delivered to the Chun King plant in 1951 and tested there [R. 182]. The machine was completely unsatisfactory [R. 183]. The machine was built and tested under secrecy conditions and when these tests proved the machine useless the tests were abandoned [R. 183, 186]. It was only later after the invention of the patent in suit that the art was taught how to modify the so-called Johnson machine to render same operative. In this modification the accused Dellenbarger machine incorporated the patented invention as will appear hereinafter more fully and thus departed from the teaching of the Johnson Patent 2,652,166.

### **(c) The Invention.**

In this background Jenö F. Paulucci conceived, around June or July of 1951, the method defined in Claim 1 of the patent in suit [R. 120]. This method of taping cans eliminated all of the then existing difficulties in the art [R. 121, 123]. The new method of taping cans eliminated the problems resulting from the difference in weight of the cans taped together and the presence of grease on the beads thereof. In addition thereto, a new, startling and highly unexpected result was attained. In applying

the tape over the irregular contour of the beads of the cans and onto the side walls thereof while in a stretched condition, the tape was extended transversely of its length with the result that the tape adheres completely to the beads and in effect “welds” the cans together [Finding of Fact 7; R. 83].

Such transverse extension of the tape and the holding force resulting therefrom is a completely unexpected and surprising result. During shipping and handling the cans responded as though welded instead of merely held together by a piece of tape. A great force is required to tear the two cans apart. An ordinary housewife would have to cut the tape to part the cans. The cans during handling are rigidly secured together preventing any relative movement there between. Where tape is normally used to hold two items together, freedom of movement between same results. This relative movement is eliminated when the patented process is utilized [Finding of Fact 7; R. 83].

Immediately after the invention of the method of claim 1 of the patent in suit, it was adopted by Chun King with a spectacular increase in Chun King’s business [R. 188, 189; Finding of Fact 10; R. 84]. Upon observing the outstanding growth of Chun King’s business and their success in the selling of taped Chinese-American foods, Oriental abandoned its paper carriers or cartons and returned to taping its cans together in 1954 [R. 492], this time the taping operation was successful because Chun King’s patented method was adopted, as will more fully appear hereafter.

The trial court after all the evidence, was convinced that the Paulucci patent and specifically claim 1 thereof was valid under all of the applicable tests and that this invention was being appropriated by Oriental.



## ARGUMENT.

### (1) The Operation of the Accused Machine.

Oriental recommenced its taping operations in 1954 [R. 468, 469], utilizing a machine identified as a Dellenbarger machine [R. 100]. This machine was brought into Court [R. 145], designated as Exhibit 21 for identification [R. 152], and was operated permitting the Trial Judge to witness and fully comprehend its construction and method of operation [R. 167]. The machine was photographed [R. 165, 166], and the photographs were designated Exhibits 21-A through 21-G, inclusive [R. 545, 551] and substituted in the record for the actual machine [R. 202].

The Dellenbarger machine is described by the witness Peterson, one of the Oriental's witnesses, in the record at pages 306, 311, and by the witness Johnson, another of Oriental's witnesses in the record at pages 318, 326. A roll of tape [see Ex. 21-C, R. 547] is mounted upon drum T which rotates freely upon the shaft that supports it [R. 324]. The tape is then trained beneath the pre-stripping roller A which is rotatably mounted [R. 324]. The tape is then reeved sticky side down over longitudinally serrated tensioning roller C which is held by tensioning ratchet B and spring D. The tape then passes beneath tape applying roller L which roller is actually a pair of freely rotating rollers E-1 and E-2 [R. 325] mounted upon the tape applying arm M. When the machine is actuated the arm M pivots moving roller L into contact with the cans being taped as seen in Exhibit 21-D thereby tacking the tape to the beads of the cans. A buffing roller P mounted upon buffing arm O is also pivoted into contact with the cans and functions to smooth out the tape on the beads of the cans.

A knife Q is likewise mounted upon arm R [R. 323]. When the cans have been taped together by being rotated in the machine the taping arm M moves upwardly out of engagement with the tape. The tape being under tension then engages the cutting edge of knife Q severing same and the machine then ejects the taped cans [R. 325].

Thus, two elements in the accused machine function to insure adequate tension in the tape to stretch same prior to application on the cans. The first element is the training of the tape through a circuitous route under pre-stripping roller A over tensioning roller C and under taping roller L which, according to Oriental's own witness Peterson, results in increased tension in the tape [R. 310]. The second tensioning element is roller C which is longitudinally serrated and engaged by tension ratchet B having a spring D engaging the serrations in roller C resisting rotation thereof to increase tension in the tape as same is drawn onto the cans [R. 308, 309].

Claim 1 may be applied to the accused Dellenbarger machine in the following manner:

(1) The method of securing two cans together, said cans having beaded ends protruding beyond their side walls, comprising aligning said cans in end-to-end relationship with adjacent end beads of said cans abutting each other.

Such structure is admittedly present in the Dellenbarger machine (Oriental's Op. Br. p. 29).

(2) Stretching a portion of a slightly resilient sticky tape and applying said portion of said tape over portions of the abutting beads and adjacent side walls of said cans together,

Referring to Exhibit 21-C it is apparent that as tape is drawn from drum T onto the cans, as same are rotated, that the tape will be under considerable tension because of the tensioning roller C, over which the tape passes sticky side down, and ratchet B and spring D, which resist rotation of roller C. This tension is greatly increased by the presence of pre-stripping roller A providing a circuitous route for the tape. This tension or resistance to pulling of the tape is sufficient to stretch the tape prior to the stretched tape being applied over the abutting beads of the cans. Thus, upon application of such tape in the stretched condition the tape passes around the beads to engage the side walls of the cans. This results in extending the tape transversely of its length at an intermediate section so that the tape "welds" the cans together. Such operation is readily apparent from the functioning of the Dellenbarger machine and was demonstrated to the Trial Court by operating the machine for the benefit of the Trial Court [Findings of Fact 7, 14, 15; R. 83, 85, 167].

Even if a "free loop" of tape existed prior to commencing the taping operation, which is not admitted, the above language of the claim still reads upon the method employed by the Dellenbarger machine in view of tensioning roller C ratchet B and spring D which function to tension the tape and stretch same. Clearly, after the asserted "free loop" has been exhausted as illustrated in Exhibit X-3 [R. 678] the tape is under tension sufficient to stretch same. There is nothing in the claim that requires any distortion of its plain language nor is there anything in the file history which limits the plain language of the claim as will be hereinafter discussed.

(3) Pulling on the portion of said tape not secured to said can in a direction substantially tangential to the periphery of the cans to place same in a stretched condition,

Obviously the tape as applied to the cans under sufficient tension to stretch same is being pulled by the tensioning roller C, ratchet B and spring D's resistance to the tape being pulled onto the cans. This pulling is augmented by the circuitous path through which the tape is trained [R. 310]. Further proof of such pulling is found in Oriental's own drawing Exhibit X-4 [R. 679] which illustrates release of the tape by lifting of the applying roller to permit the tape to rise into contact with the knife to sever same. If there were no pulling on the tape, how would it rise from the position in Exhibit X-3 [R. 678] to the position in Exhibit X-4 [R. 679]? The demonstration of the accused machine in court clearly established that this language of the claim was readable on the accused machine. Findings of Fact 14, 15 [R. 85, 167].

(4) And rotating said cans on their longitudinal axes while said tape is in said stretched condition to cause said tape to be applied and adhered to the remainder of the periphery of said beads and adjacent side walls of said cans.

Clearly the cans are rotated while tape is being applied and adhered to the periphery of the beads and adjacent side walls of the cans. Since the tape during this rotation is in a stretched condition as discussed heretofore, and as demonstrated to the Court by operation of the accused machine, this language of the claim is fully met in the accused method [Findings of Fact 14, 15; R. 85, 167].

Thus, the claim is clearly infringed by the accused method as the Trial Court found. Such findings are not clearly erroneous but to the contrary, are fully supported by the demonstration of the accused machine at the trial. Such findings are also fully supported by the Exhibits 21 A-G, X-1, X-2, X-3, X-4, and the testimony of the witnesses Peterson and Johnson, Rule 52(a), F. R. C. P.

## (2) Interpretation of the Paulucci Patent.

Oriental seeks in its opening brief to limit the scope of claim 1 by reference to the history of the patent in the Patent Office. The doctrine of file wrapper estoppel asserted by Oriental on page 31 of its opening brief, has no application to the present patent. After the application was allowed, a request was made under the provisions of Rule 312 of the Rules of Practice of the United States Patent Office to add a new claim designated claim 4. Rule 312 provides as follows:

*“Amendments After Allowance.* Amendments after the notice of allowance of an application will not be permitted as a matter of right, but may be made, if the printing of the specification has not begun, on the recommendation of the primary examiner, approved by the Commissioner, without withdrawing the case from issue.”

It is to be noted that after allowance of an application, the applicant has no right to amend same. The amendment requested under Rule 312 (formerly Rule 78) must be approved by the Commissioner of Patents before it may be entered. No appeal from the refusal to consider an amendment under Rule 312 is available. (*Ex parte Fleming*, 1907 C. D. 51.) Amendment after allowance is a matter of grace and the petition may be refused and applicant has no recourse. (*Ex parte Stone*, 1902 C. D. 434.)

A petition under Rule 312 (formerly Rule 78) is within the discretion of the Patent Office and the Examiner's report to the Commissioner is not an action in the application but serves merely as advice to the Commissioner upon which he may base his action. The applicant has no right of appeal from a holding that the claim is not patentable.



Patent Office Rules and Practice, Amdur, pages 1128 to 1130, inclusive.

An amendment under Rule 312 does not affect interpretation of the claims. Patent Office Practice (3rd Ed.), McCrady, page 421.

It is, of course, well established that a patentee cannot seek by interpretation of his claims to recapture that which he gave up in the Patent Office to obtain allowance of his patent. However, the reasoning behind this established rule is lacking in the present situation where the patentee, after having obtained allowance of his patent sought to add an additional claim thereto. In this respect the present situation is the same as in that presented to the Court in *Musher Foundation, Inc. v. Alba Trading Co., Inc.* (2d Cir., 1945), 150 F. 2d 885. Judge Learned Hand, in the opinion of the Court, stated at page 888:

“The defendant insists that the plaintiff is estopped to claim any equivalents by its cancellation of three claims (quoted in the margin<sup>2</sup>), all of which did not contain the element of heat. These claims were not cancelled to escape rejection upon a reference from the prior art cited by the examiner; they were ‘voluntarily’ withdrawn after they had been allowed along with the claims in suit. We are told that the cancellation was for the purpose of inserting them in another pending patent; but, although there is nothing to contradict this, we shall dispose of the case on the assumption that the reason does not appear, for the record is silent. It is of course a well-settled exception to the doctrine of equivalents that, when an examiner rejects a claim upon the prior art and the applicant withdraws it, the disclosure *pro tanto* passes

into the public domain. The applicant may not by resort to the doctrine of equivalent interpret any claim which he succeeds in getting allowed, so that it will cover the contents of the rejected claim without some limitation. *Smith v. Snow*, 294 U. S. 1, 14, 15; 55 S. Ct. 279, 79 L. Ed. 721; *Schreiber Co. v. Cleveland Trust Co.*, 311 U. S. 211, 220, 61 S. Ct. 235, 85 L. Ed. 132; *Exhibit Supply Co. v. Ace Patent Co.*, 315 U. S. 126, 136, 62 S. Ct. 513, 86 L. Ed. 736. The reason for this is that if the rejection is wrong, the applicant has remedies both in the Patent Office and in the courts: remedies which the cancellation of the rejected claim necessarily surrenders. That surrender does not of course result in a dedication of all species of the genus surrendered; but it does surrender any monopoly upon the genus as such: *i.e.* unless it be restricted to some species of that genus. When an applicant cancels a claim which has already been allowed, none of this reasoning applies, and at best it becomes an open question which must be proved, whether he intends to surrender the disclosure in such sense that he abandons any equivalents of the elements of those claims which he keeps. Certainly no such intent was proved here. Be that as it may, there is a conclusive reason in this case which would put Claim One outside the exception, even if it had been shown that the applicant had actually intended to surrender the contents of the cancelled claims. All of them contained as an element that the paste or the olives must be salted; and the defendant does not salt the olives out of which it makes its paste. The applicant may well have cancelled the three claims in question precisely, because they did not include that 'much less preferable' alternative, which he had disclosed and claimed. We therefore hold Claim One entitled to the same range of equivalents as though the three

claims had not been cancelled; and that, when the defendant lengthened the time and reduced the temperature, it adopted the equivalent of a 'short' time and a 'slightly elevated temperature'. *B.B. Chemical Co. v. Ellis*, 1 Cir., 117 F. 2d 829, 833, was very close on the facts."

Of course the Court in the *Musher Foundation* case determined that the cancellation of allowed claims did not result in a file wrapper estoppel, however, the reasoning underlying the decision is equally applicable in the present instance. In this case Paulucci had no remedy in the Patent Office or in the Courts for review of the action of the Patent Office in refusing to enter claim 4 by way of amendment under Rule 312 of the act being an exercise of discretion on the part of the Patent Office.

It is contended by Oriental that claim 1 of the patent in suit is limited because of the proceedings in the Patent Office in such a manner so as to not be infringed. There is nothing in the Patent Office record which requires such an interpretation. The trial court did not so interpret claim 1 and as previously pointed out in the preceding section of this brief the claim is clearly infringed by Oriental's taping process.

The reason for requesting allowance of a claim such as proposed claim 4, was a fear, which proved groundless, that allowed claim 1 might possibly be misinterpreted. The Examiner in his discretion, under Rule 312 refused to enter claim 4. The Trial Court concluded that such fears were groundless and correctly interpreted claim 1 to include Oriental's activities [Findings of Fact 14, 15; R. 85].



### (3) The Paulucci Patent Is Valid.

It is asserted in Oriental's opening brief that the Paulucci patent is invalid on its face for lack of invention. Such a statement is contrary of course, to the proofs and findings in this record [Finding of Facts 7, 8, 9, 11, 12, 13, 17, 18, 19, 20, 21, 22, 23, 24]. The record establishes three prior unsuccessful attempts by the art to accomplish the result obtained by the patented process. Chun King, prior to the Paulucci invention, endeavored to tape cans together and was unsuccessful [R. 120]. Oriental tried to tape cans together and was unsuccessful [R. 492, 495]. Minnesota Mining & Manufacturing Company tried to tape cans together and was unsuccessful [R. 183, 186]. In this background of a long felt want and with the art struggling with the problem, Paulucci conceived and perfected the patented method. The method produced a new, useful and unexpected result that is of "welding" the cans together [R. 123]. The method spells out both novelty and utility and constitutes a valuable contribution to the art.

One who had knowledge of the prior failures including the disclosure of the patents to Johnson No. 2,652,166, Nifong No. 2,120,504, would not be advised of the patented method. Nor would one skilled in the art find Paulucci's contribution to the art simple, obvious or an easy chore. The record establishes a ready and widespread acceptance of the invention on the market and widespread commercial success.

Under any of the tests of patentable invention, the method defined by claim 1 of the Paulucci patent must be deemed a patentable invention (*Coleman Co., Inc. v. Holly Mfg. Co.* (9th Cir., 1956), 233 F. 2d 71).

There is no testimony establishing or even tending to establish that Paulucci's contribution was obvious or was within the scope of ordinary skill of the calling. The evidence establishes the contrary, that prior to Paulucci's invention the art could not solve the problem.

#### (4) Chun King's Prior Taping Operation.

In May, 1949, Chun King endeavored to tape cans in an end-to-end relationship. This operation is fully described in section (B) of the Statement of the Case (*supra*). A comparison of this process with the method defined by claim 1 clearly indicates that it did not embody the invention of the Paulucci patent. There was no stretching of the tape and applying it in this condition causing the tape to pass around the irregular contour of the beads of the cans and to engage the side walls thereof, whereby the tape is extended transversely of its length which results in the cans being "welded" together [Finding of Fact 7; R. 83]. This new and unexpected result of the method of claim 1 was entirely lacking from the prior Chun King taping method.

The testimony is clear that the prior taping operation was unsuccessful [R. 120] and was abandoned [Finding of Fact 17; R. 85]. The Trial Court correctly determined that this activity constituted an abandoned experiment (*Electric Storage Battery Co. v. Shimadzu* (1939), 307 U. S. 5; *Pacific Laboratories v. Solox Laboratories* (9th Cir., 1953), 209 F. 2d 529). The evidence fully supports this determination. Thus, the prior taping operation of Chun King does not invalidate claim 1 of the Paulucci patent, first, because it did not incorporate the invention defined by claim 1 and second, because it constituted an unsuccessful and abandoned experiment.

The contention that the apparatus shown in Figure 3 of the Paulucci patent were in use in May, 1949, is not true. The quoted sections of the record do not in any way support such an interpretation [R. 43, 45-60, 63-193, 195]. The apparatus used in 1949 differed materially in structure, mode of operation and result and the claim of the filing of a false oath is without any basis in law or fact.

Since there is no claim of infringement of claims 2 and 3 and since the Trial Court limited the action to validity and infringement of claim 1 of the patent [R. 109, 110] no evidence of validity or lack thereof of these claims is present in the record. The Exhibits A and B were identified as having been taken in 1952 [R. 501, 502] not in 1949 as inferred on pages 6-8 of Oriental's opening brief.

#### (5) Oriental's Prior Taping Operation.

The nature of Oriental's June, 1949, taping operation is fully set forth in section (B) of the Statement of the Case (*supra*). It was continued until early 1950 and abandoned [R. 492, 495]. There is nothing in the record which establishes that the 1949 taping operation included applying the tape in a stretched condition. There is nothing in the record which establishes that the tape, as a result, was extended transversely at an intermediate section to adhere completely to the beads of the cans, "welding" same together. The Trial Court hence was correct in its determination that the operation did not invalidate the claim [Findings of Fact 16, 17, 24; R. 85, 87].

Also, the operation of Oriental was an abandoned experiment (*Pacific Contact Laboratories v. Solex Laboratories* (9th Cir., 1953), 209 F. 2d 529) [R. 70].

As stated in *Whiteman v. Mathews* (9th Cir., 1954), 216 F. 2d 712:

“The burden of proof imposed upon a party tendering the issue of prior public use is a heavy one. It is not satisfied by a mere preponderance of the evidence, but is borne successfully only if the evidence is clear and satisfactory—perhaps beyond a reasonable doubt.”

Oriental failed to carry this heavy burden of proof, indeed, the Trial Court upon the testimony reached the opposite conclusion. There were no exhibits, physical or documentary, which established that the taping operation in 1949 utilized the invention of Paulucci. None of the witnesses testified that the 1949 taping operation utilized the invention.

#### (6) The Johnson Patent 2,652,166 Does Not Invalidate.

On page 44 of its opening brief Oriental states:

“We concede that the operation of the machine of the Johnson patent, DX-S, would not put enough tension on the tape to stretch it . . .

“Similarly, we concede that the machine of the Johnson patent does not stretch the tape before its initial application to the cans, . . .”

Chun King fully agrees with these concessions. The Trial Court also agreed [Findings of Fact 18, 19, 20, 21, 22, 23; R. 528]. The machine sent by Minnesota Mining & Manufacturing Company to Chun King, upon which the Johnson patent 2,652,166 was based, siimilarly did not put enough tension on the tape to stretch same (Oriental's Br. pp. 13 and 14). Consequently, neither the Minnesota Mining & Manufacturing Company machine nor

the Johnson patent, based upon such machine, teach the art of Paulucci's invention.

Oriental then claims that its machine is the same as the Johnson machine and therefore does not infringe. This position is incorrect and contrary to the testimony in the record. Oriental's own witness, Peterson, clearly described the differences between the Johnson machine and the Dellenbarger machine. First, there was no pre-stripping roller such as A in Exhibit 21-C in the Johnson patent [R. 308, 309]. This addition of the roller A increased the tension on the tape [R. 310]. The roller C in Exhibit 21-C is serrated longitudinally which was not done in the Johnson machine or patent [R. 309]. A ratchet B and a tension applying spring D was added to the Dellenbarger machine Exhibit 21-C which was not present in the Johnson machine or patent [R. 309].

Thus, the Dellenbarger machine varies in two important aspects from the Johnson patent or machine, both of which were added for the purpose of increasing the tension on the tape to insure the tape would be in a stretched condition when applied to the cans. It is admitted that the Johnson patent does not teach steps 2 and 3 of the method of claim 1 [R. 68, 528]. However, the modifications in the accused machine, which were necessary to render the machine operative, insured that the machine did utilize steps 2 and 3 of claim 1. Oriental likewise admits the use of steps 1 and 4 of claim 1 [R. 520, 521].

Consequently, the Court correctly determined that neither the Johnson machine nor patent invalidated claim 1 of the Paulucci patent and that the infringing machine materially differed therefrom.



**(7) Nifong Patent 2,120,504 Does Not Invalidate.**

The Nifong patent does not teach the method defined by claim 1 of the Paulucci patent. It has been conceded by Oriental that the teaching of the Nifong patent does not teach the essential step of stretching the tape and applying it to the cans in a stretched condition. As stated in the record at page 525:

“Mr. Harris: Exactly, your Honor, and I would be the first to concede that this Nifong patent does not teach step 2 of the patent in suit, which is pre-stretching the tape before it is applied to the can.”

The Trial Court, upon investigation of the Nifong patent, agreed that the patent did not invalidate claim 1 of the Paulucci patent [Finding of Fact 18, R. 86; see also the Trial Court’s opinion, R. 68, 69].

Thus, the Nifong patent fails to invalidate claim 1 of the Paulucci patent for the same reason as the Johnson patent. It does not put enough tension on the tape to stretch same prior to application to the cans. By leaving out this step the prior art fails to attain the new and unexpected result obtained by the patented method of extending the tape transversely of its length at an intermediate section so that the tape adheres completely to the beads of the cans “welding” same together [Finding of Fact 7; R. 83].

**(8) Claims 2 and 3 Are Not in Issue.**

There is no charge of infringement of claims 2 and 3 of the Paulucci patent. There is no case or controversy with respect to these claims for the Trial Court or this Court to determine. The Trial Court limited the proofs to claim 1 of the Paulucci patent [R. 109, 110] and made no decision from which an appeal could be taken with respect to claims 2 and 3.

## Conclusion.

The Paulucci patent in claim 1 defines a method previously unknown to the art. The prior attempts to achieve the results of claim 1 were a failure. Chun King, Oriental and Minnesota Mining and Manufacturing Co. all tried, failed and abandoned their experiments at taping cans in end-to-end relationship. In this background with the art struggling with the problem unsuccessfully Jeno F. Paulucci taught the art the vital change necessary to make the taping process operative. He taught the art to put sufficient tension on the tape to stretch same and to apply the tape to the cans in this stretched condition. From this method he obtained new, unexpected and surprising results. The tape would be extended transversely of its length at an intermediate section so that the tape adhered completely to the can beads and in effect welded the cans together. This was novel, it was useful and unknown to the art. This was not obvious, it was beyond the ordinary skill of the art and was immediately adopted by the industry and has enjoyed widespread commercial success.

The prior taping operations of Chun King and Oriental did not embody this invention. It is admitted that the prior patents to Nifong and Johnson did not use this method as well as the Johnson or Minnesota Mining and Manufacturing Co. machine.

It was only after Paulucci's invention that the Dellenbarger machine was modified to include the pre-stripping roller A and the tensioning roller C with its ratchet B and spring D. Both of these modifications increased the tension on the tape. This increase in tension was sufficient to stretch the tape in accordance with Paulucci's invention prior to applying it to the cans. The demonstration of the accused machine at the trial clearly established this.

Consequently, the validity and infringement of claim 1 of the Paulucci patent 2,679,281 is clearly established in the record. The Judgment of the Trial Court is fully supported by the Findings of Fact and same are not "clearly erroneous."

As stated by this Court in *Jesse E. Hall, et al. v. Kenneth A. Wright, et al.*, Appeal No. 14626, decided January 16, 1957:

"The question of novelty and invention of a patented device or method is a question of fact. *Lane-Wells Co. v. M. O. Johnston Oil Field Service Corp.* (9 Cir.), 181 F. 2d 707, a finding of fact that the subject matter of a patent lacks invention over the state of the prior art should therefore not be disturbed unless the finding is clearly erroneous."

Further stating:

"The record is far from conclusive in favor of the finding of fact that Wright patent No. 372 lacks invention. We are of the view, however, that such finding is sufficiently supported in the evidence so that we must hold it to be not clearly erroneous."

Surely a finding of fact that the subject matter of a patent involves invention over the state of the prior art is entitled to the same treatment. Consequently, the Judgment of the Trial Court must be affirmed.

Respectfully submitted,

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